

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DANIEL C. DUAN,  
JAMES S. STEFELY, DAVID W. SCHULTZ,  
and CHESTER L. LEACH

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Appeal No. 97-2174  
Application 08/214,763<sup>1</sup>

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ON BRIEF

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Before JOHN D. SMITH, GARRIS, and WALTZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed March 16, 1994. According to appellants, this application is a continuation-in-part of Application 08/032,605, filed March 17, 1993, now abandoned.

Appeal No. 97-2174  
Application No. 08/214,763

This is a decision on an appeal from the final rejection of claims 1 through 24 which are all of the claims in the application.

The subject matter on appeal relates to a medicinal aerosol formulation which includes a dispersing aid compound comprising a chain of diol/diacid condensate units. This appealed subject matter also relates to a method of stabilizing a suspension aerosol formulation by incorporating into the formulation the aforementioned dispersing aid compound. This subject matter is adequately illustrated by independent claim 1 which reads as follows:

1. A medicinal aerosol formulation, comprising:

- (i) a dispersing aid comprising a compound comprising a chain of diol/diacid condensate units;
- (ii) a propellant; and
- (iii) a therapeutically effective amount of a particulate drug;

wherein the formulation is readily redispersible and when redispersed does not flocculate, settle, or cream so quickly as to prevent reproducible dosing of the drug.

The references relied upon by the examiner as evidence of obviousness are:

Moris (PCT)                      WO 92/00062                      Jan. 9, 1992

JP 04198394A (Derwent Abstract) 1992

Appeal No. 97-2174  
Application No. 08/214,763

Claims 1 through 24 stand rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention.

Claims 1 through 24 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Moris and the Japanese reference.

We will not sustain either of these rejections.

Concerning the section 112, second paragraph, rejection, the examiner believes that the recitation "so quickly" renders the appealed claims indefinite. This belief is clearly erroneous with respect to independent claim 24 since this claim does not contain the aforementioned recitation. The rejection is also inappropriate with respect to the other claims on appeal. As correctly indicated by the appellants in the brief, the phrase in question would have been reasonably understood by those with ordinary skill in the art particularly in light of the disclosure in the paragraph bridging pages 9 and 10 of the subject specification. That is, the claim 1 phrase "so quickly" is interpreted with respect to the prevention of "reproducible dosing", and the

Appeal No. 97-2174  
Application No. 08/214,763

term "reproducible dosing" is expressly defined at lines 4 through 7 of specification page 10. Under these circumstances, we perceive no basis with the examiner's view that "so quickly" renders appealed independent claim 1 and the claims which depend therefrom indefinite.

For the above stated reasons, we cannot sustain the examiner's section 112, second paragraph, rejection of claims 1 through 24.

Concerning the section 103 rejection, the examiner argues "it would be obvious to one of ordinary skill in the art to substitute the dispersing agent of WO 92/00062 [i.e., Moris] with the ester of JP 4,169,554 [i.e., the Japanese reference] and obtain the claimed aerosol; the motivation to do so being from the disclosure that the ester(s) of JP 4,169,554 show excellent mutual solubility/compatibility with 1,1,1,2-tetrafluoroethane, which is also the propellant of WO 92/00062" (answer, pages 3-4). The appellants are correct, however, that the solubility referred to in the Japanese reference plainly would not have motivated "one of ordinary skill in the art to substitute the dispersing agent of WO 92/00062 with the ester of JP 4,169,554" as proposed by the

examiner. This is because the applied prior art contains utterly no teaching or suggestion that such a substitution would serve any useful purpose whatsoever. In this last mentioned regard, we appreciate that the examiner has stated "[t]he surface active dispersing agent of WO 92/00062 and the acid ester of JP 4,169,554 are functionally equivalent" (answer, page 4). This statement is completely without evidentiary support. Certainly, the examiner points to nothing in the applied references, and we find nothing independently, to support the asserted equivalency. It follows that no basis at all exists for the examiner's position that an artisan with ordinary skill would have been motivated to effect the substitution under consideration.

Even if this substitution were made, it appears that the resulting formulation/method would not correspond to the formulation/method defined by the appealed claims. More particularly, we find merit in the appellants' argument that the acid esters of the Japanese reference do not correspond to the here claimed dispersing aid compound which comprises a chain of diol/diacid condensate units. On the other hand, the examiner has made no reasonably specific rebuttal to this

Appeal No. 97-2174  
Application No. 08/214,763

argument in his answer. Thus, even if the applied references were combined as proposed in the rejection, it is unclear to us and the examiner has not explained how the resulting combination would satisfy the dispersing aid limitations defined by the claims on appeal.

In light of the foregoing, we also cannot sustain the examiner's section 103 rejection of claims 1 through 24 as being unpatentable over Moris in view of the Japanese reference.

The decision of the examiner is reversed.

REVERSED

	John D. Smith	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	Bradley R. Garris	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	Thomas A. Waltz	)	

Appeal No. 97-2174  
Application No. 08/214,763

Administrative Patent Judge )

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Appeal No. 97-2174  
Application No. 08/214,763

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